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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of

Glennis Orloff et al.

Title: Multiple Microblade Hair Removal
Devices and Methods for Manufacture

Serial No.: 09/626,193

Filed On: July 28, 2000

)
) Examiner: B.D. Ashley
)
) Group Art Unit: 3724
)
) Confirmation No. 3154
)
)
) (Docket No.: 6579-0110)

Board of Patent Appeals and Interferences
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

This is a reply to an Examiner's Answer mailed on August 5, 2005, in the above-identified appeal to the Board of Appeals.

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REMARKS

In the Examiner's Answer, the Examiner makes three points, which are summarized below. The third point in the Examiner's Answer is directed to the substance of the application and is therefore addressed first. The procedural issues raised by the Examiner are addressed after the substantive issue.

The substantive issue addresses whether U.S. Patent No. 5,100,506 to Sturtevant et al. (hereinafter "Sturtevant") discloses the claimed invention. The Examiner alleges that Sturtevant discloses a substantially planar and rigid substrate and at least 100 micro-blades. Using the reference numerals of the Sturtevant reference, the Examiner equates the flat, front surface (53) of a metal blank with the claimed substrate and the tooth shapes (51) and cutting edges (57) with the claimed micro-blades. The Examiner also acknowledges that one must look to the specification to understand the claim language, but then he alleges that there is no requirement to incorporate structure from the specifications into the claims.

Appellants respectfully disagree with the Examiner's characterization of the prior art as well as his interpretation of the requirements for claim construction. First, with regard to the Examiner's characterization of the Sturtevant reference, it should be noted that Sturtevant discloses bent-up tabs having sharpened edges, whereas claim 64 recites micro-blades. Micro-blades, as recited in the claims and defined in the specification, are clearly not bent-up tabs. Second, the Examiner's allegation that there is no requirement to incorporate structure from the specification into the claims is erroneous. It is, of course, well-settled that a patentee may act as his own lexicographer in a patent application provided that the terms are defined where there is a need to coin new expressions with which to communicate the invention. The inventor's definition and explanation of the meaning of a word, as evidenced by the specification, controls the interpretation of that claim term, as opposed to dictionary definitions. Although the ordinary and accustomed meaning of a term initially serves as a default meaning, a different meaning clearly and deliberately set forth in the written description of the specification controls the meaning of a term. The meaning that Appellants ascribe to "micro-blade" is clearly set forth in the written description. Appellants find it puzzling

that the Examiner would acknowledge that one must look to the specification to understand the claim language but then assert that to do so is discretionary, particularly with regard to the term “micro-blade.” Thus, Appellants respectfully submit that the Examiner is required to afford the definition of “micro-blade” as recited in the specification significant deference and that merely dismissing it as allegedly being discernible from the context of the application is an unreasonable error.

Furthermore, as argued in the Appeal Brief, Sturtevant is non-analogous art. As stated in the Appeal Brief, the invention recited in the claims is directed to shaving implements, whereas Sturtevant is directed to methods of chemically etching cutting tools, none of which are capable of realistically being used to shave. In fact, the Examiner focuses on Sturtevant’s Figure 5, which we note is explicitly referred to at column 6, lines 1-8 of the Sturtevant reference, as being a micro-planing strip 47 that is fittable into a hacksaw frame. Because Sturtevant provides no definition of the term “planing,” we use the standard dictionary definition and assume it refers to the shaping of some material (e.g., wood). It is unlikely that anyone would plane their face in an effort to remove hair. It is Appellants’ intent with this patent application to provide users with a *reasonable* method of removing hair, namely, shaving via the micro-blades by cutting the hair without damaging the skin. Accordingly, because micro-blade shaving devices have nothing to do with planes used to shape a surface, Appellants respectfully submit that the Sturtevant reference is non-analogous art.

With regard to the first point raised in the Examiner’s Answer, the Examiner notes that Appellants, in the Appeal Brief, disagreed with the Examiner’s non-entry of the proposed amendments as allegedly requiring at least further consideration. The Examiner indicates that the issue of whether Appellants disagree with the non-entry of the amendment is not an appealable matter. Appellants respectfully submit that even if the articulation of the disagreement is misplaced, it is worthy of inclusion in the Appeal Brief because it has a direct bearing on the Examiner’s second notable point, which is addressed below.

In the second point raised in the Examiner’s Answer, the Examiner indicates that the language “the micro-blades are configured for cutting hair when drawn across a skin surface and without damaging the skin” is merely functional and does not define any

specific structure. Appellants respectfully submit that this language should remain. It is appropriate to point out that Appellants disagree with the Examiner's non-entry of the proposed amendments because the proposal to amend claim 64 to recite "said cutting edge [being] positioned below a cutting edge support surface" provides structural subject matter that is directly associable with the claim language that the Examiner alleges is functional. Positioning a cutting edge below a support surface allows a micro-blade defined by the cutting edge and the support surface to be drawn across a skin surface without damaging the skin. This is due to the support surface riding on the skin surface and spacing the cutting edge off the skin surface.

Appellants believe the non-entry of the proposed amendments to be worthy of argument in the Appeal Brief because of language put forth by the Examiner in the final Office Action, which was mailed on December 21, 2004. In that final Office Action on page 2 in the rejections made under 35 U.S.C. §102, the Examiner provided reasons why claim 116 was allegedly anticipated by Sturtevant. Then the Examiner opined "[i]t should be noted that the specific language 'the micro-blades are configured for cutting hair when drawn across a skin surface and without damaging the skin' is merely functional/intended use recitations not defining any specific structure. In apparatus claims functional/intended use language does not serve to distinguish the claimed invention from the prior art; apparatus claims must be defined over the prior art in terms of structure ...". The Examiner made a similar statement on page 4 of the final Office Action in the rejections made under 35 U.S.C. §103. Appellants understand that functional language does not serve to distinguish the claimed invention from the prior art, but they cannot draw any plausible line of reasoning between the anticipation/obviousness rejections made and the respective following paragraphs that describe "functional/intended use" language. The MPEP explicitly states that functional language does not, in and of itself, render a claim improper. Sturtevant clearly does not disclose any semblance of language directed to cutting hair without damaging the skin, functional or structural. Accordingly, Appellants construed the Examiner's statement on functional language as an invitation to structural-ize the language of claim 116 by amending the claims as proposed to overcome the anticipation and obviousness rejections.

In the Examiner's response to Appellants' arguments that the non-entry of the proposed amendments would not raise new issues, the Examiner disagrees with Appellants' contention that the proposed claim language already existed in the claims. In particular, the Examiner indicates that although "the proposed language is in claim 116, the metes and bounds of claim 64 are not the same as claim 116" and that "[t]he proposed claim language was never considered in combination with at least 100 micro-blades as found in claim 64 ..." Claim 116 was added in response to the non-final Office Action of July 15, 2004, and was never rejected or objected to. Claim 116 depends directly from claim 64. It is Appellants' understanding that a dependent claim incorporates all the subject matter from the claims from which it depends. Appellants are confused by the Examiner's indication that the subject matter of claim 116 (the dependent claim) has not been considered in combination with the subject matter of claim 64 (the independent claim from which claim 116 depends). It would seem to Appellants that claim dependency is *prima facie* support for considering language from one claim in combination with language from another claim. Thus, Appellants maintain the position that the non-entry of the proposed amendments in which claim 116 is incorporated into claim 64 does not raise a new issue.

The Examiner also disagrees that the specification supports the proposed changes. As stated above, the claim language for the proposed changes to claim 64 is found in claim 116. Claim 116 recites (and thus claim 64 was proposed to recite) each of the micro-blades comprising a blade support and a blade attached to the blade support, each blade having a cutting edge. Support for these recitations is found on page 9, lines 13-16, of the specification in the language "Figures 1 and 2 [illustrate a] micro-blade unit 10 which comprises a blade support 12, a blade 14 having a cutting edge 15 and a cutting edge support 16." Claim 116 also recites the blade being attached to the blade support and elevated above a flat upper surface of a substrate. In language having the same effect, claim 64 was proposed to recite the blade being elevated relative to the substrate. Support for this recitation is found on page 10, lines 1-3, which describes blade support height "in order to elevate blade 14 ... from the substrate." Lastly, Figures 1 and 2 clearly show the cutting edge 15 positioned below the cutting edge support surface 16. Given that Appellants can point to this language in the text and to the Figures in the

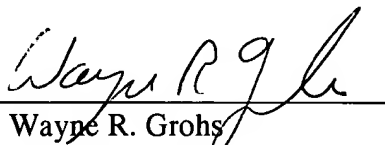
drawings of the application as originally filed, Appellants respectfully assert that the proposed changes are in fact supported by the specification.

The Examiner also indicates that the entry of amendments after final rejection cannot be made as a matter of right. Appellants are well aware of this. However, 37 CFR §1.116, which forms the basis for the Examiner's statement, states (in part), "[a]fter a final rejection ... [a]n amendment presenting rejected claims in better form for consideration on appeal may be admitted ..." Although the word "may" seems to indicate that the entry of such an amendment is at the discretion of the Examiner, Appellants fail to understand why the incorporation of subject matter of a dependent claim (claim 116) into the independent claim (claim 64) from which it depends is not tantamount to presenting the rejected claims in better form for consideration, particularly when the subject matter is clearly supported in the specification and in the dependent claim. Furthermore, Appellants respectfully assert that the level of consideration required by the Examiner to determine if the proposed amendments were worthy of entry would be minimal because the proposed amendments merely involved the incorporation of subject matter from a dependent claim to its independent claim.

For the reasons discussed above and in the Appeal Brief, Appellants maintain that this application is in a condition for allowance and thus reversal of the outstanding rejections and allowance of the application is appropriate.

If any charges are incurred with respect to this Reply Brief, they may be charged to Deposit Account No. 503342 maintained by Appellants' attorneys.

Respectfully submitted,

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